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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,723	01/28/2002	Sigfrid Schwarz	1815	5696

7590

07/11/2003

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EXAMINER

RAO, DEEPAK R

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/11/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/937,723

Applicant(s)
Schwarz et al.

Examiner
Deepak Rao

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 16, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 ☒ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-15, 20, and 21 ☒ are allowed.
- 6) ☒ Claim(s) 16 and 17 ☒ are rejected.
- 7) ☒ Claim(s) 18 and 19 ☒ are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11 6) ☐ Other:

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DETAILED ACTION

This office action is in response to the amendment filed on June 16, 2003.

Claims 10-21 are pending in this application.

The following rejections are withdrawn:

The rejections under 35 U.S.C. 112, second paragraph of the previous office action are withdrawn in view of applicant's remarks and amendments.

The rejection under 35 U.S.C. 112, first paragraph as applied to claims 18-19 is hereby withdrawn in view of the amendments and remarks.

The following rejections are maintained:

Claims 16-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the treatment of diseases such as ischemia, asthma, etc. (as disclosed in page 3 of the specification), does not reasonably provide enablement for the prophylaxis of the same. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The reasons provided in the previous office action are incorporated here by reference.

Applicant's arguments have been fully considered but they were not deemed to be persuasive. Applicant first submits that the instantly claimed compounds due to their anti-oxidative activity are useful in treating certain types of diseases and conditions (see page 8 of

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paper no. 10). Further, applicant relies on EP 436936 and indicates that 'the reference teaches many of the diseases that are mentioned in applicant's specification are **treatable** by administration of anti-oxidant compounds' (see pages 8-9 of paper no. 10). However, the claims still encompass any and all diseases because the claims do not specifically recite that the diseases are related to the anti-oxidant activity. Even with respect to the therapeutic approach of anti-oxidant related diseases, the state of the art is quite speculative as can be seen from the reference(s) cited in the previous office action.

Further, applicant asserts that 'the specification contains more than sufficient information for one skilled in the art to use the compounds to **treat** diseases and/or conditions that are known to be caused by oxygen free radicals' (see page 9). However, contrary to this assertion, the claims continue to recite 'geroprophylaxis' and thus, include diseases those that are known to exist and those that are yet to be discovered and therefore, the use of the phrase is extremely broad. The claim does not specify the mode of action or what type of person would be 'in need of' such 'geroprophylaxis'.

Applicant provides that the term 'geroprophylaxis' refers to 'gerontological diseases and conditions' and indicates that 'one skilled in the medical art would understand the scope of the diseases that are **treatable** by the methods of the claims' (see page 6). However, the term "prophylaxis" is same as "prevention" of the disease and applicant's assertion in the arguments as well as the description in the specification is towards 'treatment' of certain specific diseases related to antioxidative activity. The instant term includes administering the compound to an

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otherwise healthy person for any reason. Applicant's attention is directed to the previous office action (pages 4-5) wherein reasons were provided for the non-enablement of the use of the term. It is treatment of the patient population that is achieved by diagnosis of the common risk factors and prescription of the appropriate drugs and not 'prevention'.

For all the above reasons it is maintained that the entire scope of the instant claims is not enabled.

Claim Objections

Claims 18-19 are objected to because of the following informalities:

The claims do not recite "a the person in need thereof" which will enhance the clarity of the claim. Appropriate correction is required.

Allowable Subject Matter

Claims 10-15 and 20-21 are allowed, for the reasons provided in the previous office action.

Receipt is acknowledged of the Information Disclosure Statement filed on June 16, 2003 and copy is enclosed herewith.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

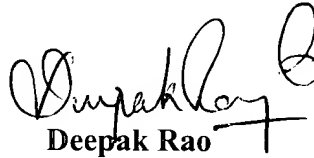
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Deepak Rao
Primary Examiner
Art Unit 1624

July 10, 2003